

**CUSTOMER NO.: 24498**  
**Serial No.: 10/510,605**  
**Office Action dated: 01/06/09**  
**Response dated: 04/06/09**

**PATENT**  
**PU020102**

**Remarks/Arguments**

In the Non-final Office Action dated January 6, 2009, it is noted that claims 1-21 are pending in this application; that claims 1-21 stand rejected under 35 U.S.C. §103; and that the drawings filed on October 8, 2004 have been accepted by the Examiner.

By this response, claims 3, 6, 12, 15, and 17 have been amended to be in independent form including substantially all limitations of respective base claim and of any intervening claims between respective base claims and amended claim; claim 3 has also been amended to include the limitations from claim 2; claim 12 has also been amended to include the limitations from claim 11; claim 19 has been amended to correct an inadvertent error and to include limitations from claim 21; claim 21 has been amended to delete the limitations now present in claim 19; and claims 1, 2, 10, and 11 have been cancelled without prejudice. In addition, the dependency of claim 8 has been changed to be from claim 3, while the dependency of claim 17 has been amended to be from claim 12. The amendments to these claims are believed to be proper and justified. No new matter has entered.

**Cited Art**

The following references have been cited and applied in the present Office Action: U.S. Patent Application Publication No. 2003/0227567 to Plotnick et al. (hereinafter referenced as "*Plotnick*"); U.S. Patent Application Publication No. 2002/0100041 to Rosenberg et al. (hereinafter referenced as "*Rosenberg*"); U.S. Patent 7,061,549 to Mabon (hereinafter referenced as "*Mabon*"); U.S. Patent Application Publication No. 2002/0194595 to Miller et al. (hereinafter referenced as "*Miller*"); U.S. Patent 6,698,020 to Zigmund (hereinafter "*Zigmund*"); U.S. Patent Application Publication No. 2005/0149981 to Augenbraun et al. (hereinafter referenced as "*Augenbraun*"); and U.S. Patent Application Publication No. 2002/0056107 to Schlack (hereinafter referenced as "*Schlack*");

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Rejection of Claims 1, 2, 8, 10, 11, and 17 under 35 U.S.C. §103

Claims 1, 2, 8, 10, 11, and 17 stand rejected under 35 U.S.C. §103 as being unpatentable over Plotnick in view of Rosenberg. Claims 1, 2, 10, and 11 have been cancelled without prejudice. Claims 8 and 17 have been amended to be dependent from amended claims 3 and 12, respectively. This rejection is respectfully traversed.

Plotnick appears to teach an interactive television system in which the user is able to navigate between standard television services and interactive services such as video-on-demand and the like. Plotnick achieves this by transferring focus from one application to another using a device such as a remote control device or computer based peripherals such as a wireless keyboard or the like. Plotnick appears to state that "hot keys" are used to provide a particular input to which the set-top converter responds. As admitted in the present Office Action, Plotnick does not teach any limitations of claim 2 involving the mute key, mute signal, or mute-to-interactive application feature. Rosenberg was added to Plotnick to cure allegedly these defects.

Rosenberg appears to teach a system in which ads are inserted into a video replay system when the client initiates a pause of the replay or at some time delayed from the pause. The display of ads is configurable by the client-user. Other action key functions are proposed by Rosenberg to achieve other functionality with the inserted ads.

Rosenberg does not teach, show, or even remotely suggest the existence or use of a mute key, mute signal, or a mute-to-interactive application feature as defined in claim 2. Even the present Office Action lacks any citation to an express teaching by Rosenberg about the use of a mute key, mute signal, or a mute-to-interactive application feature. Instead, the present Office Action assumes that, since the pause button causes an interruption of the replay and because the pause action stops the sound from playing as well as the action, the pause is functionally equivalent to a mute action.

Pause and mute are clearly different functions that provide different results. Pause is not suggestive of mute. Pause causes a cessation of all sound and video action whereas mute does not. Because of the significant differences between these functions, it is believed that the only way one would begin to analogize them is through the use of improper hindsight using the teachings of the present application as prior art against itself. Without hindsight, pause and mute functions will not arise as being remotely similar.

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Rosenberg and Plotnick lack any teaching, showing, or suggestion of the additional limitations added by independent claim 3 into claim 8. Mabon was added to this combination of references to allegedly cure the defects in Rosenberg and Plotnick. However, Mabon does not cure these defects with respect to the go-back channel key, the go-back channel signal, and the switching that is caused thereby.

Mabon allows the user to dwell on certain channels which are known as a channel of interest to permit the user to jump back to that channel at a later time. Mabon allows this identification and jumping back within the same application. There is no suggestion in Mabon or the other references that a jump back (or go-back) input from the user in one application will cause the present application to be switched to a previous application last viewed by the user. Applications and channels are not suggestive of each other. Mabon only shows a single application in use. Mabon stores channels, not applications, as the last viewed items. Thus, Mabon, in combination with Plotnick and Rosenberg, does not teach, show, or suggest the limitations of independent base claim 3 and dependent claim 8. Since claim 17 includes similar limitations as claims 3 and 8 due to its dependence from amended claim 12, it follows that Mabon, in combination with Plotnick and Rosenberg, does not teach, show, or suggest the limitations of independent base claim 12 and dependent claim 17.

In light of the remarks above, it is submitted that the combination of Plotnick and Rosenberg, even including Mabon, fails to teach all the elements of claims 8 and 17. It is believed that the elements of these claims would not have been obvious to a person of ordinary skill in the art upon a reading of Plotnick and Rosenberg, either separately or in combination, even when Mabon is included in the combination. Thus, it is submitted that amended claims 8 and 17 are allowable under both 35 U.S.C. §103. Withdrawal of this rejection is respectfully requested.

Rejection of Claims 3-5, 12-14, and 19-20 under 35 U.S.C. §103

Claims 3-5, 12-14, and 19-20 stand rejected under 35 U.S.C. §103 as being unpatentable over Plotnick in view of Rosenberg and further in view of Mabon. This rejection is respectfully traversed.

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Independent claim 19 also includes limitations from claim 21 relating to downloading and switching modes while the download is in progress. None of the applied references herein even hint at the operation or mode switching while a download is in progress. Thus, the combination of Plotnick, Rosenberg, and Mabon also fail to teach, show, or suggest these latter limitations of claim 19. The references of Augenbraun and Schlack have been added to Plotnick and Rosenberg with respect to at least the portion of the limitation from claim 21 now present in claim 19. The remarks below distinguishing Augenbraun and Schlack from claim 21 are incorporated herein to show that the combination of Plotnick, Rosenberg, Augenbraun, Schlack, and Mabon fail to teach, show, or suggest the limitations of claim 19.

In light of the remarks above, it is submitted that the combination of Plotnick, Mabon, and Rosenberg, even when supplemented with the teachings of Augenbraun and Schlack, fails to teach all the elements of the amended independent claims 3, 12, and 19 and the claims dependent thereon. It is believed that the elements of these claims would not have been obvious to a person of ordinary skill in the art upon a reading of Plotnick, Mabon, and Rosenberg, either separately or in combination, even when supplemented with the teachings of Augenbraun and Schlack, as noted above. Thus, it is submitted that claims 3-5, 12-14, and 19-20 are allowable under both 35 U.S.C. §103. Withdrawal of this rejection is respectfully requested.

Rejection of Claims 6, 7, 15, and 16 under 35 U.S.C. §103

Claims 6, 7, 15, and 16 stand rejected under 35 U.S.C. §103 as being unpatentable over Plotnick in view of Rosenberg further in view of Miller and further in view of Zigmond. This rejection is respectfully traversed.

Claims 6 and 15 introduce the limitation of a commercial skip feature which permits modes to be switched when the commercial is detected. Claims 7 and 16 introduce the additional feature of switching back from the interactive application mode to the television program mode when the end of the commercial is detected. These features are automatically performed when the commercial skip key/signal makes the feature operative.

Rosenberg, as discussed earlier, permits the insertion of advertising when the user initiates a pause in video replay. Rosenberg does not switch modes from a television program mode to an interactive application mode to perform this ad insertion.

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Zigmond is substantially cumulative to the teachings of Rosenberg with respect to insertion of advertising. In Zigmond, start of a commercial in a broadcast feed (called a trigger event by Zigmond) is detected and then a new, more targeted, substitute commercial is inserted into the broadcast feed in place of the original commercial. The mode is not switched in Zigmond.

Miller is substantially similar to Zigmond and Rosenberg in the substitution of some type of content for commercials in a broadcast stream. Miller lacks any suggestion that the mode should be switched when the commercial begins or ends.

All commercial insertion or substitution is performed by Miller and Zigmond on the television viewing stream. There is no mode switching suggested in either reference when the advertising is substituted into the broadcast feed.

In light of the remarks above, it is submitted that the combination of Plotnick, Rosenberg, Miller, and Zigmond fails to teach all the elements of independent claims 6 and 15 and the claims dependent thereon. It is believed that the elements of these claims would not have been obvious to a person of ordinary skill in the art upon a reading of Plotnick, Rosenberg, Miller, and Zigmond, either separately or in combination. Thus, it is submitted that claims 6, 7, 15, and 16 are allowable under both 35 U.S.C. §103. Withdrawal of this rejection is respectfully requested.

Rejection of Claims 9, 18, and 21 under 35 U.S.C. §103

Claims 9, 18, and 21 stand rejected under 35 U.S.C. §103 as being unpatentable over Plotnick in view of Rosenberg further in view of Augenbraun and further in view of Schlack. This rejection is respectfully traversed.

Augenbraun does not operate with different modes. Instead, Augenbraun utilizes different channels in which television, or Internet, or other viewing options can be broadcast. See *Augenbraun at paragraph [0009]*. So interactive channels are just that, channels, they are not switchable modes. When downloading of web-pages is requested by a user, Augenbraun clearly states that the user is unable to watch any television programming during downloading. The time away from the television program is minimized by caching information at the headend. When the information is ready to be downloaded to the user, the television programming is interrupted and the channel is switched to the internet related channel so that downloading can be completed.

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*See Augenbraun at paragraph [0011].* Augenbraun teaches just the opposite of the claimed limitations since the user in Augenbraun is not permitted to be watching their television broadcast until the download is complete.

Schlack is not suggestive of download times related to a threshold. While Schlack does discuss a threshold, it is in reference to a time since the user's last channel change. Statistics are maintained on the channel changing by a user to target substitute advertising changes for that user. In this regard of substitute advertising, Schlack is cumulative to the teachings of Rosenberg, Zigmund, and Miller, all discussed above. Thus, Schlack does not teach all the limitations of claim 9.

In light of the remarks above, it is submitted that the combination of Plotnick, Rosenberg, Augenbraun, and Schlack fails to teach all the elements of claims 9, 18, and 21. It is believed that the elements of these claims would not have been obvious to a person of ordinary skill in the art upon a reading of Plotnick, Rosenberg, Augenbraun, and Schlack, either separately or in combination. Thus, it is submitted that claims 9, 18, and 21 are allowable under both 35 U.S.C. §103. Withdrawal of this rejection is respectfully requested.

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Conclusion

In view of the foregoing, it is respectfully submitted that all the claims pending in this patent application are in condition for allowance. Entry of this amendment, reconsideration, and allowance of all the claims are respectfully solicited.

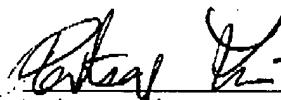
If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner contact the Applicant's attorney at (609) 734-6813, so that a mutually convenient date and time for a telephonic interview may be scheduled for resolving such issues as expeditiously as possible.

Please charge the \$440 fee for the two newly added independent claims, and any other costs that may be due, to Deposit Account No. 07-0832.

Respectfully submitted,

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